UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MONAGHAN MEDICAL CORP.,
Petitioner

v.

SMITHS MEDICAL ASD, INC.,
Patent Owner.

Case No. IPR2018-01466

Patent No. 7,059,324

Issue Date: June 13, 2006

Title: Positive Expiratory Pressure Device With Bypass

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR LEAVE TO FILE A BRIEF CONSTRUING CHALLENGED CLAIMS UNDER A DISTRICT COURT-TYPE STANDARD

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
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I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

Patent Owner Smiths Medical ASD, Inc. ("Smiths Medical") hereby opposes Petitioner Monaghan Medical Corp.'s ("Monaghan") Motion for Leave to File a Brief Construing the Challenged Claims Under a District Court-Type Standard ("Motion"). The Board should deny the relief requested because Monaghan has at all turns failed to comply with both the content and the spirit of the rules. Not only did the Board not give permission to file the Motion, Monaghan never even actually requested permission to file its Motion. (Exhibit 1017.) Finally, Petitioner should not be rewarded for its failing to follow the rules because of Smiths Medical would be prejudiced by Monaghan's behavior. Even under the best of conditions, Smiths Medical will not be given notice prior to filing its preliminary response which standard will be applied. Therefore, Smiths Medical will have to brief both constructions, the very thing Monaghan has suggested was too large a burden to place on it.

II. GOVERNING LAWS, RULES, AND PRECEDENT

Pursuant to 37 C.F.R. § 42.100(b), "[a] party may request a district court-type claim construction approach to be applied if a party certifies that the involved patent will expire within 18 months from entry of the Notice of Filing Date Accorded to [the] Petition."

In the commentary to the current version of Rule 37 C.F.R. § 42.100(b), the Patent Office explained:

> A request by either party for a *Phillips*-type construction must be done by motion, triggering a conference call with the panel to discuss the request to resolve whether such a motion is appropriate under the circumstances and whether any other briefing is necessary for each party to be able to address adequately the appropriate construction standard. For instance, petitioner **may** be afforded an opportunity to address a *Phillips*-type construction analysis **before patent owner is required to file its preliminary response**.
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> …
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> [A] motions practice in which the petitioner **may** be able to brief an alternative construction **before a patent owner files its preliminary** response **may** be an efficient way to proceed, but such choice is left to the discretion of the panel… [T]he Office **prefers** to resolve the applicable claim construction standard before institution, **and ideally, before the patent owner preliminary response deadline has passed**.

81 Fed. Reg. 18752, 18753. (Emphasis added.)

III. THE BOARD SHOULD DENY MONAGHAN LEAVE TO ADDRESS CLAIM CONSTRUCTION ACCORDING TO A DISTRICT COURT-TYPE APPROACH IN THIS PROCEEDING

Monaghan should not be allowed leave to file additional briefing for district court-type claim constructions. First, there was no burden on Monaghan to make its arguments in the petition. At the time it filed its petition, the parties had already argued their respective claim construction positions in court and the Court had already issued a claim construction order. (Petition at 14; Ex. 1015.) It should have been a simple matter to include its already-established positions in its Petition.

Second, Monaghan should not be rewarded for failing to follow the rules and procedures established by the Board. Smiths Medical requested permission to file motions for district court-type claim construction in two separate IPR proceedings. (Ex. 1017.) The Board granted permission for Smiths Medical to file its motions. (*Id.*) However, Monaghan never requested permission from the Board, nor did the Board give approval for Monaghan to file its Motion. (*Id.*) The only permission granted by the Board was for Smiths Medical to file "motions for District Court type claim construction." (*Id.*)

Third, "[a] motion may only be filed according to a schedule set by the Board" and "will not be entered without Board authorization." 37 C.F.R. §§ 42.20(b), 42.25. Monaghan has never asked for, nor has the Board provided a briefing schedule to brief this issue. Therefore, according to the default briefing schedule under 37 C.F.R. § 42.25, since Monaghan's Motion was filed on August 31, 2018, and allowing for two months for the filing for an opposition and reply brief, Monaghan's reply would not be due until October 21, 2018, just a short time before the preliminary response is due. As a result, even if the Board decided the Motion immediately, and Monaghan supplemented briefing on its constructions immediately, Smiths Medical would be faced with briefing both claim constructions in its preliminary response – the very thing that Monaghan argued would have been unduly burdensome for it. This is inconsistent with the commentary to the official rules where the Board stated the claim construction issue should ideally be decided and addressed by patent owner before the patent owner preliminary response deadline has passed. 81 Fed. Reg. 18752, 18753. Placing the burden to brief both variations on Patent Owner is unfair and prejudicial to Smiths Medical.

Fourth, Monaghan never identified prejudice (other than cost and general burden) that it would suffer if it were not allowed further briefing, and it never

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